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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,215	03/24/2006	Dieter Doehring	BARDP0126US	4813
23908 7590 08/02/2010 RENNER OTTO BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE NINETEENTH FLOOR CLEVELAND, OH 44115				
EXAMINER O HERN, BRENT T				
ART UNIT		PAPER NUMBER		
1783				
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08/02/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/595,215	Applicant(s) DOEHNING, DIETER
Examiner BRENT T. O'HERN	Art Unit 1783

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 2, 4, 8-11 and 17-20.
Claim(s) withdrawn from consideration: 12-14.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1783

Continuation of 3. NOTE:

Amended independent claim 19 limiting the coating to only an amino-silane promoter introduces new issues that require further consideration/search. Amended independent claim 19 does not place the application in better form for appeal as new issues are presented by the amendment.

Continuation of 11. does NOT place the application in condition for allowance because:

The amended claims do not place the application in condition for allowance as further consideration/search is required to determine whether the claims are patentable over the prior art.

In response to Applicant's arguments (See p. 5, para. 1 of Applicant's paper filed 7/26/2010.) that a person would not refer to Shirano because Shirano is directed to an ink acceptor layer while Dohring ('984) and O'Dell are directed to laminate panels, it is noted that said arguments are not persuasive. Dohring ('984) is directed to decorative papers that are impregnated with an amino resin and particles that are usable in laminates (See Abstract and col. 1, l. 47 to col. 2, l. 11.). Shirano is directed to decorative papers that are impregnated with an amino resin and particles (See Abstract, col. 2, ll. 29-67 and col. 4, ll. 6-21.). Thus, since both Dohring ('984) and Shirano are directed toward decorative papers impregnated with amino resin and particles it would have been obvious to look to Shirano.

In response to Applicant's arguments (See p. 5, para. 2 of Applicant's paper filed 7/26/2010.) that Dohring ('984) and O'Dell do not mention the dies of treating particles with a resin to lead to optically and mechanically improved surfaces and a person would not refer to Shirano because Shirano is directed to an ink acceptor layer while Dohring ('984) and O'Dell are directed to laminate panels and Dohring ('984) does not teach coating particle prior to adding to a dispersion but rather teaches using a dispersion of an amino resin, it is noted that said arguments are not persuasive. Applicant's arguments are not commensurate in scope with the claims. The claims do not claim any dies or any specific optical or mechanical properties. Dohring ('984) specifically states the papers are "decorative" and "patterned" and "highly wear resistant" (See col. 1, ll. 7-11.), thus, these materials are optically attractive and mechanically improved.

In response to Applicant's arguments (See p. 6, para. 1 of Applicant's paper filed 7/26/2010.) that Shirano does not provide any hint or information for the skilled person to do so and only teaches modifying a silica powder to increase adsorption to provide an improved printing material, it is noted that said arguments are not persuasive. The first part of Applicant's arguments are not clear as a reference statement appears to be missing from the conclusion. Perhaps Applicant means to refer back to the arguments regarding the other references. Independent claim 19 is directed to a paper that can be used for a panel and not a panel. Shirano is not cited for teaching the entire claim but rather for using a silane adhesion for modifying silica powder (See Abstract and col. 2, ll. 29-67.).

In response to Applicant's arguments (See p. 6, para. 2 of Applicant's paper filed 7/26/2010.) that O'Dell teaches preparing a dispersion containing water, binder material and abrasion-resistant particles and not the same abrasion resistant particles as claimed, it is noted that said arguments are not persuasive. Independent claim is broad with the particles only being described as "abrasion resistant particles". O'Dell specifically states its particles have "better initial wear resistance" (See col. 6, ll. 42-48.), thus this type of particle satisfy Applicant's broad particles per independent claim 19. Furthermore, the primary reference Dohring ('984) teaches the specific particles (See col. 1, l. 47 to col. 2, l. 11 and Abstract.) as claimed in the dependent claims.

In response to Applicant's arguments (See p. 7, para. 1 of Applicant's paper filed 7/26/2010.) that Dohring ('600) does not teach coating abrasion particles but rather using a dispersion of a melamine resin and one would not have predicted that the coating would provide superior optical and mechanical properties, it is noted that said arguments are not persuasive. Dohring ('600) teaches paper for a laminate panel where the particles together with amino resin are sprayed onto the paper (See para. 29.). Thus, since the resin and the particles are in a same mixture the particles are clearly coated. Dohring's ('600) product is patterned, decorative and wear resistant (See paras. 5, 7, 9 and 26.).

In response to Applicant's arguments (See p. 7, paras. 2-3 of Applicant's paper filed 7/26/2010.) that Jaisle does not cure the deficiencies of the other references for claims 8-9, it is noted that no precise arguments are set forth.

/Brent T O'Hern/
Examiner, Art Unit 1783